

U.S. Patent Application Serial No. 10/082,089  
Response filed December 1, 2004  
Reply to OA dated September 9, 2004

### **REMARKS**

Claims 8, 13 and 18-20 are pending in this application. Claims 12 and 14-17 have been canceled without prejudice or disclaimer. Claim 8 has been amended and new claims 18-20 have been added in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention. The applicants respectfully submit that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated **September 9, 2004**.

Support for the amendment to claim 8 may be found in the specification as follows:

Support for the recitation of the release agent may be found on page 23, lines 5-10, of the specification, and in the Examples in Tables 2 and 5. The release agent is dispersed in the polyester resin, and the release agent is a carnauba wax or a tetrabehenate ester of pentaerythritol.

The preparation for resin solution containing the release agent in claim 8 is described on page 34, lines 1-11, of the specification.

New claim 18 depends from claim 13, and limits the organic pigment to formula 8.

Support for new claims 19 and 20 may be found in the specification on page 38, lines 12-21.

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**Claims 8 and 12-17 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office action paragraph no. 5)**

The rejection of claim 8 is overcome by the amendment to the claim. The rejection of claims 12 and 14-17 is moot in view of the cancellation of these claims without prejudice or disclaimer.

The Examiner refers to the recitation of “phase inversion accelerator which **may be** methanol, ...” in claim 8. This portion of the claim has been amended to “phase inversion accelerator is selected from methanol, ....”.

**Claims 14-17 are rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over US 6,063,537 (Nakamura), as evidenced by Japanese Patent 2000-81734 (JP '734). See the DERWENT translation of JP '734 for cites. (Office action paragraph no. 8)**

The rejection is moot in view of the cancellation of claims 14-17 without prejudice or disclaimer.

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**Claims 14-17 are rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over US 6,265,125 B1 (Anno), as evidenced by JP '734. See the DERWENT translation of JP '734 for cites. (Office action paragraph 9)**

The rejection is moot in view of the cancellation of claims 14-17 without prejudice or disclaimer.

**Claims 8, 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno, as evidenced by JP '734, combined with US 6,183,924 B1 (Nomura). See the DERWENT translation of JP '734 for cites. (Office action paragraph 10)**

The rejection of claims 8 and 13 is overcome by the amendment of claim 8. The rejection of claim 12 is moot in view of the cancellation of claim 12 without prejudice or disclaimer.

Claim 8 is amended by adding a limitation that the color toner includes a releasant. Support for this amendment is discussed above. By the method of claim 8, as amended, the powder toner having a preferable particle size distribution can be easily produced by using a specific wax.

As the Examiner asserted, Anno discloses an emulsion dispersion granulation method. However, **neither Anno nor Nomura discloses a method including the process of adding wax with the mixing process of phase inversion accelerator.**

The examples that use dispersion (W1) of the tetrabehenate ester of the pentaerythritol and the dispersion (W2) of Carnauba wax have excellent particle size distribution  $Dv/Dn$  as described in Table 5 of the present application specification. The example in which the numerical value is

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small is Sharp for particle size distribution. Page 40, lines 14-19, in the present specification discuss the particle size distribution.

These waxes exhibit good dispensability especially to the polyester resin and markedly improve the fixing properties and anti-offset properties. When using these waxes as a toner for non-magnetic one-component development in the case of printing a number of sheets over a long time, they stably charge the toner without being deposited on a charge material pressed against a developing sleeve, thus making it possible to print a high-grade and fine image free from image defects and contamination. When a color toner is produced by using in combination with the colorant of the formula 1 of the present invention, it is made possible to obtain a color toner having excellent transparency as compared with a hydrocarbon wax such as polypropylene wax. The color toners having these properties have transparency and are suited for use in printing on an OHP sheet that requires a sharp projected image, and printing of a natural color having good color reproducibility by overlapping of two or more colors. See page 23, line 11 to page 24, line 2.

In the present invention, **resin solution** to which the releasant disperses is prepared, and it is mixed with the aqueous medium in the presence of a base and a phase inversion accelerator. This preparation method brings the toner of the powder with a desirable particle size distribution.

Applicant asserts that neither Anno nor Nomura suggests the limitations of claim 8, and that claims 8 and 13, as amended, are novel and non-obvious over the combination of Anno with Nomura '924.

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**Claims 8, 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with US 2002/0037466 A1 (Kanbayashi) and Nomura. (Office action paragraph 11)**

The rejection of claims 8 and 13 is overcome by the amendment of claim 8. The rejection of claim 12 is moot in view of the cancellation of claim 12 without prejudice or disclaimer.

As noted in regard to the rejection over Anno and Nomura in paragraph no. 10, claim 8 has been amended to add a limitation that the color toner includes a releasant. Applicant has asserted that neither Anno nor Nomura discloses a method including the process of adding wax with the mixing process of phase inversion accelerator. Applicant submits that Kanbayashi also fails to disclose or suggest this, and therefore the combination of references does not support a *prima facie* case of obviousness. Therefore, claims 8 and 13, as amended, are novel and non-obvious over the combination of Anno, Nomura, and Kanbayashi.

**Claims 8, 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with JP '734 and Nomura. See the DERWENT translation of JP '734 for cites. (Office action paragraph 12)**

The rejection of claims 8 and 13 is overcome by the amendment of claim 8. The rejection of claim 12 is moot in view of the cancellation of claim 12 without prejudice or disclaimer.

Applicant's arguments above regarding the combination of Anno and Nomura apply to the combination of Anno, JP '734 and Nomura.

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**Claims 8, 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with US 2002/0058193 A1 (Tosaka), as evidenced by the ACS File Registry Nos. 56396-10-2, 6448-96-0, and 12225-06-8, and Nomura. See the DERWENT translation of JP '734 for cites. (Office action paragraph 13)**

The rejection of claims 8 and 13 is overcome by the amendment of claim 8. The rejection of claim 12 is moot in view of the cancellation of claim 12 without prejudice or disclaimer.

In addition to the above arguments, Applicant respectfully submits that Tosaka does not disclose or suggest a method including the process of adding wax with the mixing process of phase inversion accelerator, and that claims 8 and 13 are novel and non-obvious over the combination of Anno, Tosaka and Nomura.

**Claims 14-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, 9-11, 24 and 25 of copending Application No. 09/791,860 (Application '860) in view of JP '734. See the DERWENT translation of JP '734 for cites. (Office action paragraph 17 (note: numbering out of sequence))**

The rejection is moot in view of the cancellation of claims 14-17 without prejudice or disclaimer.

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**Claims 8, 12 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, 9-11 and 14-25 of copending Application '860 in view of Kanbayashi.** (Office action paragraph no. 16 (note: numbering out of sequence))

The rejection of claim 12 is moot in view of the cancellation of claim 12 without prejudice or disclaimer.

The rejection of claims 8 and 13 is obviated by the filing of a terminal disclaimer over Application '860. The terminal disclaimer paper is co-filed with this Amendment.

In view of the aforementioned amendments and accompanying remarks, claims 8, 13 and 18-20, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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